

The opinion in support of the remand being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT E. USNER, GLENDA K. GRISWOLD,  
OMAR EL-KAISSI, JAMES CHURCH, JAY PAUL DRUMMOND, DALE BLACKSON,  
LILEI CHEN, BOB A. CICHON, MARK S. COVERT,  
BRADRIK Q. LEPPER, MARK A. MOALES, MARK D. SMITH,  
ROBERT J. LEMLEY, MICHAEL A. CALIFF, JR., SHAWN D. JOYCE,  
PHILLIP S. MOORE and STEVEN C. SWINGLER

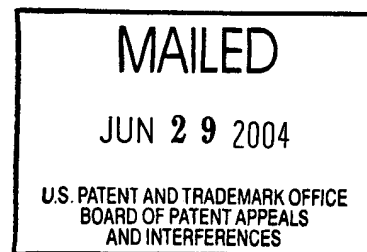
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Appeal No. 2003-0831  
Application 09/193,647

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ON BRIEF

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Before HAIRSTON, DIXON, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this application is not in condition for a decision on appeal. Accordingly, for the reasons which follow, we remand the application to the examiner for consideration of our findings and to take appropriate action.

DISCUSSION

We begin with the relevant procedural history. In a Pre-amendment filed with the application (Paper No. 4, filed November 17, 1998), appellants filed "ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED." In the transmittal papers, appellants claimed priority of earlier filed Provisional Application 60/031,956 filed November 27, 1996. In the first Office action, (Paper No. 7) the examiner failed to acknowledge appellants' claim for priority.

Appellants submitted amendment B (Paper No. 9, filed May 21, 2001) in response to the examiner's first Office action (Paper No. 7, mailed March 14, 2001). In the amendment, appellants state (page 2), under the heading "Cross Reference to Related Applications" that:

This application is a continuation-in-part of Serial No. 09/077,337 filed May 27, 1998 which is the national phase of International Application PCT/US97/21422 filed November 25, 1997 which claims benefits of Provisional application 60/031,956 filed November 27, 1996, and this Application also claims benefit of Provisional Application 60/091,887 filed July 7, 1998 and Provisional Application 60/095,626 filed August 7, 1998, and Provisional Application 60/098,907 filed September 2, 1998.

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In addition, appellants state (page 9) that:

Applicants Request Acknowledgment Of Their Right to Priority. The Application has been amended herein to provide a cross reference to the related applications. Such a reference to these related applications and Applicants' claim to the benefit thereof was indicated in an Amendment included in the Transmittal filed with the Application November 17, 1998. This Amendment is found at pages 1 of 2 of the Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed. Applicants are presenting this Amendment to assure that their claim for priority is recognized. The Examiner is also thanked for the courtesy of the interview on March 26, 2001. During the interview, the undersigned pointed out to the Examiner that the present Application claims priority of several prior Applications and that features recited in the independent claims are disclosed and are entitled to the benefit of Provisional Application 60/031,956 filed November 27, 1996."

Moreover, in the amendment, appellants assert, inter alia, (page 11) that the rejection of claims 1-5, 7, 8, and 11-13 under 35 U.S.C. § 102(a) as being anticipated by the BankNet Article is traversed because "[t]he present application is entitled to the benefit of U.S. provisional application 60/031,956 filed November 27, 1996." Appellants assert (id.) that because the BankNet Article has a publication date of April 11, 1997, that the BankNet Article does not constitute prior art.

In response, the examiner issued a final rejection (Paper No. 10, mailed August 14, 2002). In the final rejection, the

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examiner neither acknowledged appellants claim for priority based upon the November 27, 1996 Provisional Application, nor did the examiner provide any reasons why the examiner does not consider appellants to be entitled to the November 27, 1996 filing date.

In the appeal brief (Paper No. 15, filed January 22, 2002) appellants (pages 10 and 11) once again asserted, inter alia, that the BankNet Article does not constitute prior art because appellants are entitled to the benefit of the filing date of Provisional Application 60/031,956 filed November 27, 1996.

In the examiner's answer (Paper No. 16, mailed April 9, 2002) the examiner, once again, did not address appellants assertion that the BankNet Article was not prior art against appellants. In the examiner's answer, the claims are rejected as follows<sup>1</sup>:

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<sup>1</sup>We note that in the examiner's answer, the examiner refers back to both Paper No. 7 (first Office action) and Paper No. 10 for the rejection of claims. The application was returned to the examiner (Paper No. 19, mailed August 15, 2002) without being docketed, by an Administrator at the Board, due to the examiner's reliance to more than one prior Office action. In response, (Paper No. 21, mailed November 20, 2002) the examiner withdrew reliance on Paper No. 7, and stated that the examiner was relying on Paper No. 10, instead of relying on Paper Nos. 7 and 10 as set forth in the answer. Our difficulty with the examiner's assertion is that in Paper No. 7, claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over BankNet in view of Zeanah. Since the examiner is no longer relying on Paper No. 7, the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over BankNet in view of Zeanah, is unclear as the examiner lists Zeanah as being applied against the claims (answer, page 3) and responds to appellants' arguments with respect to Zeanah (answer, page 4). Thus, the status of claim 10 and the rejection of claim 10 under 35 U.S.C.

(continued...)

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Claims 1-5, 7, 8, and 11-13 stand rejected under 35 U.S.C. § 102(a) as being anticipated by BankNet.

Claims 6,9, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over BankNet.

Claims 16-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vak et al.

Because the BankNet Article has been applied against almost all of the claims on appeal as the base reference, the issue of whether the reference is prior art against appellants needs to be addressed.

Accordingly, the examiner needs to address the issue of whether appellants have complied with 35 U.S.C. § 119(e), and to determine whether appellants are entitled to the benefit of the November 27, 1996 filing date of Provisional Application 60/031,956, as asserted by appellants. In making the determination of whether appellants are entitled to the earlier filing date, the examiner's attention is directed to MPEP (Eight Edition, Revision 1, February 2003) § 706.02 which recites, in

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<sup>1</sup>(...continued)

§ 103(a) as being unpatentable over BankNet in view of Zeanah is unclear. We additionally note that although claim 10 was rejected over BankNet in view of Zeanah in the first Office action (Paper No. 7), the rejection was not repeated in the final rejection (Paper No. 10) but was repeated in the examiner's answer.

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part, under the heading "DETERMINING THE EFFECTIVE FILING DATE OF THE APPLICATION" that "[t]he effective filing date of a U.S. application may be determined as follows: . . . [i]f the application \*\*>properly claims benefit< under 35 U.S.C. 119(e) \*>to< a provisional application, the effective filing date is the filing date of the provisional application >for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application.<."

In addition, the examiner should clarify the status of the rejection of claim 10.

#### SUMMARY

This application is remanded to the examiner for appropriate action consistent with our findings, supra. This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure (MPEP) § 708.01(D) (Eight Edition, Revision 1, February 2003). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal of this case.

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REMANDED

  
KENNETH W. HAIRSTON  
Administrative Patent Judge

  
JOSEPH L. DIXON  
Administrative Patent Judge

BOARD OF APPEALS  
AND  
INTERFERENCES

*Stuart S. Levy*  
STUART S. LEVY  
Administrative Patent Judge

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